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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,653	04/26/2001	Raymond Floyd Babcock	ROC9-2000-0295-US1	9684

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,653

Applicant(s)

BABCOCK ET AL.

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,871,629 to Bunyea.

Bunyea '629 teaches Applicant's claim limitations including : a "housing" – including 34, comprising "first and second rails" – part 64 has "first and second rails" (96,96) as shown in Fig 9, that are in the interior of the housing" – 34 as shown in Fig 1.

Alternatively, the structure used to guide latching action/parts including partitions 80 as shown in fig 3 for example and described in written description read on limitation of "rails". Both/either interpretations of the structure of the reference anticipates broad limitation. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on"

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something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Bunyea '629 also teaches : an "end stop" – lower portion of housing (as shown in Fig 5) bracing part 58, a "battery compartment" – central opening for receiving 44,72,74 as shown on the face of the patent, a "battery latch" including 58, "protruding member" – portion(s) of 58 that actually engage and hold battery pack, a "slide button" – 66, at least one "battery pack retainer recess" – cross-section of recess space including range of movement of latch portions of spring 58 where present limitation does not define any particular structure that can be relied upon to patentably distinguish from the arrangement of the prior art, an "enclosure" – including 44,72,74, at least one "extending portion that is configured to go in the at least one battery pack retainer recess of the housing when the battery pack is installed in the housing" – including 76, "portion of the enclosure including at least one recess" – portion receiving 78 as shown on the face of the patent.

As regards claims 17 and 18, one of ordinary skill in the art would recognize that intended use of the structure of the prior art inherently anticipates broadly-recited method steps of the claims. For example, it's noted that Fig's 4 and 5 of the reference specifically teach the limitation where its noted that the slide button is explicitly shown extending through the housing into a space between the arms of the latch thereby closing off access to the latch from outside of the housing and thereby inherently functioning to retain the latch therein.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,567,545 to Murakami in view of U.S. Pat. No. 4,791,756 to Simpson.

Murakami '545 teaches limitations including : a "body portion" - 13, "at least one resilient spring element" - the legs projecting from either side of part 13, "at least one protruding member" - 13a,

As regards the claim, part 13a extends into a recess in a battery compartment as shown in Fig 6 for example, and part 12 reads on "housing", "first and second rails in the interior of the housing" reads on rail structure illustrated adjacent parts 12a (near opening for part 13a) as shown on the face of the patent. The housing's back wall opposite the housing's opening for part 13a reads on limitation of "end stop", functioning as a support, or "end stop" for the latch's integral spring arms, a "battery compartment" – cavity portions defined by 12,1 as shown in Fig 6, an "elongated slot" – opening for part 13.

Murakami '545 teaches the claimed invention except for a removably attached slide button. However, it is well known in the art to attach slide buttons to the latch body using a push-in snap connection including an "opening" 96 in the latch, at least one "retaining portion" (107) on the button (102) for engagement through the housing's (42)

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"elongated slot" (62) as shown by Simpson '756 for example. It would have been an obvious design choice or engineering expedient to manufacture the latch of Murakami '545 with a slide button made separately and snapped into engagement with the latch body as taught by Simpson '756 in order for the slide button to aid in retention of the parts in their assembled position and/or to provide a slide cover for the slot, both attributes of the separately-attached button being well known to those of ordinary skill in the art. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect the function of the disclosed latch device. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

The two-part button/latch of Simpson '756, as applied to the latch of Murakami '545 would inherently click and couple the slide button to the latch body portion and retain the battery latch in the housing as recited due to the abrupt retaining structure taught by Simpson '756 and the fact that the button structure on the one side, and the latch structure on the other side of the slot, are both physically larger than the slot dimension whereby their interconnection through the slot inherently performs function of retaining.

Response to Arguments

Applicant's arguments regarding "the claimed rails are part of the housing and on the interior of the housing" is more specific than claim limitation of "housing

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comprising,..., first and second rails in the interior of the housing,..., an end stop in the interior of the housing,..., a battery compartment,..., a battery latch,..., a slide button,..., at least one battery pack retainer recess". The above shorthand is used to emphasize that as the invention is defined in the claim, the "housing" includes several elements, including elements that are specifically disclosed to not be integral with the housing per se. The language of the claim does not patentably distinguish from the structure of the prior art. Regardless, it is fair to say that the rails (96,96) of the reference are 'part of the housing' since they are in use connected with the balance of the housing in the assembly. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974). Applicant argues that parts 96,96 "does not in any way appear to be related to the claimed structure of a rail in the housing". In response it is noted that parts 96,96 are explicitly illustrated to be in the housing and notes art-accepted definition of 'rail'.

rail 1 >noun 1 a bar or series of bars fixed on upright supports or attached to a wall or ceiling, serving as part of a fence or barrier or used to hang things on. 2 a steel bar or continuous line of bars laid on the ground as one of a pair forming a railway track. 3 railways as a means of transport.

The reference discloses a series or pair of bars fixed to a support that form a track to provide guidance for linear transport of the pushbutton mechanism.

As regards additional, separate grounds of rejection holding that parts 80 of the reference anticipate "rails" limitation, contrary to applicant's arguments, the slide button is explicitly shown to slide between the rails as determined from comparison of Fig's 4, 5 and the illustration on the face of the Patent (Fig 3).

Similar considerations of claim scope vs. scope of limitations argued apply to arguments against the spring latch of the reference anticipating claimed spring. The claim does not include limitations to require the distinctions which Applicant argues. Even where Applicant's arguments use quotation marks to denote "a battery latch with at least one,..." claim limitation, the quotation does not appear to be accurate with respect to the actual claim limitation of claim 16 for example whereby reference to the actual pending claims is suggested for evaluation of the prior art. The 'spring' of the reference is directly placed against the 'end stop' of the prior art as it is identified in the grounds of rejection (where otherwise the spring would be unconstrained and would simply slide away and not be able to produce any spring bias). The test for patentability is not whether the prior art can be described using different terminology than is used for Applicant's disclosed invention but whether or not the terms of the claims can be read on the structure of the prior art.

Although claims 17 and 18 are phrased as a method, the 'providing' step presents essentially the same limitations as claim 16 and the examiner's interpretation of the structure of the prior art is not substantially different as regards that same

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structure and is not repeated. One of ordinary skill in the art should recognize that broadly recited steps of "installing" and "removing" are central to the concept of the prior art and taught thereby. It is further noted that new limitation added by amendment does not define any structure (within context of its being 'provided') that is not taught by the reference as is more specifically pointed out in the grounds of rejection above.

It is not clear if Applicant's arguments for patentability of claim 19 indicate that combination of prior art does not teach any particular steps or all structures. No issue has been raised as regards obviousness of the combination.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

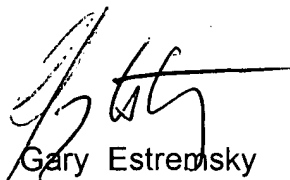
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
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